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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/149,629	09/08/98	PECTEAU	K 96-18140

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EXAMINER
SCHWARTZ, J

ART UNIT	PAPER NUMBER
2873	2

DATE MAILED: 12/16/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/149,629

Applicant(s)
Fecteau et al.

Examiner
Jordan M. Schwartz

Group Art Unit
2873



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1 and 17 (and their respective dependent claims) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reference to claims 1 and 17, claiming "A lens comprising a lens..." renders the claims vague and indefinite since it implies a lens within a lens i.e an imbedded lens. It is suggested that in line 3 the words "a lens having" be deleted to provide the necessary clarity.

Claim Objections

Claim 11 is objected to because of the following informality: "dual lens section" should be corrected to "dual lens sections". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinbloom.

Feinbloom discloses the limitations therein including the following: see Figure 4 and column 6, line 65 to column 7, line 5 and column 8, line 26 disclosing a first surface defined by

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rotating an aspheric shape about an axis offset from an axis of the aspheric shape; the second surface formed such that the lens provides zero power (column 8, line 26 i.e. to give the proper prescription); the aspheric shape comprising an ellipse; the first surface defined by rotating an ellipse about an axis which is coplaner, parallel to and offset from an axis of the ellipse (Figure 4, "H-H", column 6, line 65). With respect to the claimed varying the thickness to provide zero power, it is believed that this feature would be inherent in the lens of Feinbloom, this being reasonably based upon Feinbloom disclosing that the curvature of the exterior surface being varied to provide the necessary prescription (which could be no power at all). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the lens made of formed polymeric material since the use of such material is well known in the art as a material used to form ophthalmic lenses. Furthermore, lacking criticality the use of such material would be an obvious matter of design choice. With respect to the rotation with respect to the major vs. minor axis and to the infinitely distanced limitation, applicant has not set forth any criticality for these features as set forth above and such features would therefore be an obvious matter of design choice. With respect to the limitation of the two surfaces together providing zero power, or varying the lens thickness to provide zero power, Feinbloom discloses as is set forth above. Regardless, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate this feature since Feinbloom teaches that the second surface is formed to give "the proper prescription" which could obviously be no prescription at all

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and which could obviously be varying lens thickness when the curvature is varied to provide no prescription at all.

Claims 1-10, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinbloom in view of Bright.

Feinbloom discloses as is set forth above and the use of formed polymeric material in the lens of Feinbloom would be obvious for the reasons set forth above. Regardless, Bright teaches of forming a lens surface having a complex aspherical shape of formed polymeric material to provide lenses of improved cost weight and strength (column 1, line 22, column 2, line 20 and column 4, line 34). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the lens of Feinbloom of a formed polymeric material since Bright teaches of the advantages of such a material in lenses having complex aspherical surfaces to provide a lens of improved cost, weight and strength.

Double Patenting

Claims 1-13 are rejected under the judicially created doctrine of double patenting over claims 1-62 of U. S. Patent No. 5,825,455 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a lens having a first surface formed by rotating an aspheric shape about an axis offset from an axis of the aspheric shape and the second surface formed to provide zero power.

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Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Allowable Subject Matter

Claims 11-16 and 21-23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph (as well as the double patenting rejection), set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. In reference to the allowable subject matter, none of the prior art either alone or in combination disclose or teach the claimed combination of limitations specifically including, in reference to embodiments in which eyewear is located spaced from the eyes, the limitation of the surface formed by rotating an aspheric shape about an axis which axis is not an axis of said aspheric shape

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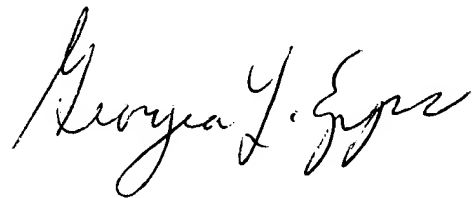
and which is offset from an axis of the aspheric shape or the claimed coplanar, parallel to and offset from an axis limitation as well as the claimed second surface formed to provide zero power.

Prior Art Citations

Davis et al. Tedesco, and Sansalone are being cited herein to show lenses having similar structure to that of the claimed invention.

Telephone Inquiry Contact

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jordan Schwartz whose telephone number is (703) 308-1286.

A handwritten signature in black ink, appearing to read "Georgia Epps". The signature is fluid and cursive, with the first name "Georgia" and last name "Epps" clearly distinguishable.

**Georgia Epps
Supervisory Patent Examiner
Technology Center 2800**

Jordan Schwartz

December 11, 1998